



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/961,319

09/25/2001

Misako Suwa

826.1757

5814

21171

7590

08/08/2006

STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

FILIPCZYK, MARCIN R

ART UNIT

PAPER NUMBER

2163

DATE MAILED: 08/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/961,319	SUWA ET AL.	
	Examiner	Art Unit	
	Marc R. Filipczyk	2163	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4,7,8,11,14,15,18 and 21-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4,7,8,11,14,15,18 and 21-25 is/are rejected.
- 7) ☒ Claim(s) 19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

This action is responsive to Applicant's amendment filed June 5, 2006.

Claims 1, 4, 7, 8, 11, 14, 15, 18 and 21-24 are pending and new claim 25 is submitted.

To expedite the process of examination Examiner requests that all future correspondences in regard to overcoming prior art rejections or other issues (e.g. amendments, 35 U.S.C. 112, objections and the like) set forth by the Examiner that Applicants provide and link to the most specific page and line numbers of the disclosure where the best support is found (see 35 U.S.C. 132).

Claim Objections

Claim 19 is objected to because of the following informalities: Claim 19 has previously been cancelled. Applicant is requested to correctly label claim 19 in the next correspondence.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 25 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth whether the invention accomplishes a practical application and whether it generates a useful, concrete and tangible result.

The guidelines explain that a practical application of a 35 U.S.C. 101 judicial exception is claimed if the claimed invention physically transforms an article or physical object to a different

Art Unit: 2163

state or thing, or if the claimed invention otherwise produces a useful, concrete, and tangible result.

In the present case, independent claim 25 does not involve transformation of article or physical object to a different state or thing, it merely recites extracting data. Further, independent claim 25 does not produce a useful, concrete, and tangible result, but merely searches extracted data and does not permanently change the data or store search results for reuse. State Street, 149 F.3d at 1373-74, 47 USPQ2d at 1601-02.

Claim 25 taken as a whole is directed to a mere method, does not comprise a practical application as explained above hence is nonstatutory.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 23 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 23, the term “making” a handwritten note is indefinite. It is not clear if the note is written or made.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2163

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4, 7, 8, 11, 14, 15, 18 and 21-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ching (U.S. Patent No. 6,533,168) in view of Takeda et al (U.S. Patent No. 4,748,678).

Regarding claims 1, 8, 15 and 22-25 Ching discloses a method, program and system for electronically managing a note taken in a paper document printed from an “electronic document not including the note” (hereafter, original document) when the document is printed and used by a person, comprising: (figures 1a and 3, item 304, and col. 4, lines 9-14, Ching)

reading as an image a document printed on a paper, said document having a note written thereon (col. 4, lines 9-14, 17 and 18, Ching)

extracting information about the note from the read image of the document printed on the paper and a note handwritten on the paper; (col. 4, lines 9-14, Ching)

recognizing a character written in the image data of the note; (col. 10, lines 32-41, Ching)

searching (*purchaser*, fig. 9, item 903, Ching) contents of the electronic document and the recognition result of character contents of the hand written-note (*database*, fig. 9, item 912, Ching) in accordance with a search keyword input from a user (*purchased request*, fig. 9), and displaying a search result; (fig. 1b, item 112 and fig. 9, Ching)

(Note 1: database includes contents of electronic document and the recognition result, see support [col. 4, lines 14-24, lines 49-54, col. 10, lines 39-42 and col. 14, lines 3-9, Ching])

(Note 2: information is stored in database for retrieval/search)

correlating and electronically storing the information about the note with the read image (col. 4, lines 14-17, and col. 10, lines 32-43, Ching) but does not explicitly teach correlating the original document with the information about the note and that the image data of the note is obtained by taking a difference between the original document and the read image.

However, Takeda teaches storing and retrieving image system that correlates an original document with information about a note (figures 7, 8, 11 and col. 9, lines 3-20, Takeda) and obtaining an image of the note by taking the difference between the original document and the read image (figures 7 and 8, Takeda).

Hence, having Ching system correlating information about the note with the read image (col. 10, lines 40-42, Ching), it would have been obvious to a person of ordinary skill in the art at the time the invention was made to correlate the information about the note with the original document as done in Takeda. One would have been motivated to store the correlation information about the note and the original document to keep track of the note and the related original document to avoid storing the read image which includes the original document with a note.

Further, having Ching system, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to obtain an image of the note by taking a difference between the original document (receipt) and the read image (receipt with note) as done in Takeda (figures 7 and 8, Takeda). One would have been motivated to take the difference between the receipt and the receipt with a note to exclusively store the image of the note for future processing.

Art Unit: 2163

(Note: obtaining an image of the note by taking the difference between the original document and the read image is shown in fig. 7 and supported by location attributes in fig. 8 of Takeda)

Regarding claims 4, 11 and 18, Ching/Takeda disclose the original document, a note image and a recognition result of the hand written note image are correlated and electronically stored (figures 7, 8, 11 and col. 9, lines 3-20, Takeda, see also *[col. 4, lines 14-24, lines 49-54, col. 10, lines 39-42 and col. 14, lines 3-9, Ching]*).

Regarding claims 7, 14 and 21, Ching/Takeda disclose location information of the note within the printed document (fig. 8, Takeda).

Response to Arguments

Applicant's amendment and arguments filed on June 5, 2006 have been fully considered but they are not persuasive. The arguments and responses are listed above.

Applicant argues on page 10 of the 6/5/06 response that Takeda and Ching do not teach searching contents of the database based on user input.

Examiner disagrees. Ching system clearly discloses a database with contents of documents and annotations wherein notes are taken and are associated together, are stored in database for later retrieval based on user search. Please see also *[col. 4, lines 14-24, lines 49-54, col. 10, lines 39-42 and col. 14, lines 3-9, and figures, Ching]*. Takeda further teaches storing

Art Unit: 2163

and correlating an original document with information about a note (figures 7,8,11 and col. 9, lines 3-20, *Takeda*). Together Ching/Takeda teach the claimed system.

No other arguments have been raised.

With respect to all the pending claims 1, 4, 7, 8, 11, 14, 15, 18 and 21-25, Examiner respectfully traverses Applicant's assertion based on the discussion cited above.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc R. Filipczyk whose telephone number is (571) 272-4019. The examiner can normally be reached on Mon-Fri, 8:30am-5pm.

Art Unit: 2163

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on 571-272-1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MF
July 31, 2006


DON WONG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100